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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,765	10/30/2003	Alessandro De Matteis	141483.00002-P1241US00	8891

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EXAMINER

ADAMS, GREGORY W

ART UNIT	PAPER NUMBER
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3652

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/697,765

Applicant(s)

MATTEIS, ALESSANDRO DE

Examiner

Gregory W. Adams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ * Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 & 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 & 12 the claimed steps relate to a method of separating a stack of sheets. However, Applicant is respectfully reminded that to be entitled to patentable weight in method claims, the structural limitations recited therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. See *Ex parte Pfeiffer*, 135 USPQ 31 (1961). Here, Applicant is claiming a method but in some respects the recitations do not recite an active step, e.g. claims 1 & 12 in some cases do not have a "forming", "separating", "providing" or "using" -ing ending word that provide active steps.

For examination purposes, it is assumed that Applicant intended to recite in claim 1:--

- a) forming a stack of interfolded sheets piling up on a table located underneath;
- b) separating two successive interfolded sheets once achieved a predetermined height of said forming stack and defining a completed stack and a forming stack;

- c) said separating occurring by laterally introducing a first and a second separator into said stack being formed from opposite sides with respect to the stack same for separating the stack located underneath and for leaving at least one wing of sheet hanging free between said two separators;
- d) moving away said completed stack of sheets from said table and leaving it on a conveyor belt or an outlet plane;
- e) moving a sheet stretching board suitable for provisionally supporting the stack and stretching said or each wing, with a portion of wing of sheet exceeding said sheet stretching board;
- f) withdrawing said first and second separator up to reaching a position external to said stack being formed; and
- g) moving back said table and withdrawing the sheet stretching board, with said portion of wing that remains between said stack and said table.--

And in claim 12:--

- a) forming a stack of interfolded sheets piling up on a table located underneath;
- b) separating two successive interfolded sheets once achieved a predetermined height of said forming stack and defining a completed stack and a forming stack;
- c) said separating occurring by laterally introducing a first and a second separator into a forming stack from opposite sides with respect to the forming stack same for separating the stack located underneath, a forming stack having a width and introducing two separators about half the width bearing

together the stack being formed, leaving at least one wing of sheet hanging free between said two separators the two separators leaving, the wing hanging at about half of the width;

- d) moving away said completed stack of sheets from said table and leaving it on a conveyor belt or an outlet plane;
- e) moving a sheet stretching board suitable for provisionally supporting the stack and stretching said or each wing, with a portion of wing of sheet exceeding said sheet stretching board;
- f) withdrawing said first and second separator up to reaching a position external to said stack being formed, and
- g) moving back said table and withdrawing the sheet stretching board, with said portion of wing that remains between said stack and said table.--

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11 are rejected under 35 U.S.C. 102(a) as being anticipated by Schmidt, V et al. (US 6,322,315).

With respect to claim 1, Schmidt, V et al. disclose a method for separating a stack of sheets already formed from a stack being formed, during the production of paper packed products, comprising the steps of:

- formation of a stack of interfolded sheets 30 that are piled up on a table 10, 36 located underneath;
- separation of two successive interfolded sheets once achieved a predetermined height of said stack being formed, thus defining a completed stack 30 and stack being formed 58 (FIG. 5);
- said separation occurring by lateral introduction of a first 46 (or 48) and a second 50 separator into a stack being formed and from opposite sides with respect to a stack same for separating a stack located underneath and for leaving at least one wing 70 of sheet hanging free between said two separators;
- moving away a completed stack of sheets from said table and leaving it on a conveyor belt or an outlet plane (FIG. 6);
- moving a sheet stretching board 48, suitable for provisionally supporting a stack and stretching said or each wing, with a portion of wing of sheet exceeding said sheet stretching board (FIG. 10; C10/I65-67);
- withdrawing first 46 and second 50 separators up to reaching a position external to a stack being formed (FIG. 12); and
- moving back a table 10 and withdrawing a sheet stretching board 48, with said portion of wing that remains between said stack and said table (FIG. 11).

With respect to claim 2, Schmidt, V et al. disclose that before moving back said table an element 52 moving from a direction opposite to said sheet stretching board stretches said portion of wing of sheet exceeding said sheet stretching board.

With respect to claim 3, Schmidt, V et al. disclose a step is provided of making an end fold on the portion of said wing exceeding said sheet stretching board by means of both an element acting from the opposite side to said sheet stretching board and an element moving from the same side of said sheet stretching board, just before coming back said table.

With respect to claim 4, Schmidt, V et al. that said element acting from the same side is a blow of air 52, and said element acting from the opposite side of said sheet stretching board is said second separator, said separator moving from a position outer to the stack, after that said sheet stretching board is positioned, to a position below the lower face of said sheet stretching board and in order to make the end fold on the exceeding portion of sheet by said blow of air.

With respect to claim 5, Schmidt, V et al. that where previously to the step of moving away said completed stack on the conveyor belt 68, or in the outlet plane, a blow of air 52 is provided for moving a possible last sheet that has remained in a vertical position bringing it to a horizontal position.

With respect to claims 6 & 9, Schmidt, V et al. disclose means 22, 24 for feeding said stack being formed with a stream of interfolded sheets, movable table 10, first and second separators 46, 50 moving laterally into sack from opposite sides and a sheet stretching board 48 (C10/L65-67).

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With respect to claims 7-8, Schmidt, V et al. disclose an element 52 comprising a blow of air moving from a direction opposite to said sheet stretching board, with respect to the processed stack, suitable for stretching said portion of wing of sheet exceeding said sheet stretching board just before coming back said table.

With respect to claim 10, Schmidt, V et al. disclose that said sheet stretching board slides on a base integral to said support of said fl6st separator-in a direction orthogonal to said sliding direction operated by an actuator that causes it to move along this direction.

With respect to claim 11, Schmidt, V et al. disclose said table is located on a slide movable horizontally along a guide operated by an actuator.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hauschild et al. (US 5,730,695) (previously cited) in view of Schmidt, V et al. (US 6,322,315) (previously cited).

With respect to claim 12, Hauschild et al. discloses a method for separating a stack of sheets already formed from a stack being formed, during the production of paper packed products, comprising the steps of:

- a) formation of a stack 2' of interfolded sheets that are piled up on a table 22, 23 located underneath;
- b) separation of two successive interfolded sheets once achieved a predetermined height of said stack 2' being formed, thus defining a completed stack 2 and a stack 2' being formed;
- c) said separation occurring by lateral introduction of a first 11 and a second 12 separator into a stack being formed and from opposite sides with respect to the stack same for separating the stack located underneath, a stack having a width and two separators 11, 12 being introduced in a stack for about half the width bearing together the stack being formed, the two separators leaving at least one wing of sheet hanging free between said two separators, the wing hanging at about half of the width;
- d) moving away said completed stack of sheets from said table and leaving it on a conveyor belt or an outlet plane;
- e) stretching said or each wing, with a portion of wing of sheet exceeding said sheet stretching board;
- f) withdrawing said first and second separator up to reaching a position external to said stack being formed;
- g) moving back said table and withdrawing the sheet stretching board, with said portion of wing that remains between said stack and said table; and

does not disclose moving a sheet stretching board and stretching said or each wing, with a portion of wing of sheet exceeding said sheet stretching board. Schmidt, V et al.

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disclose moving a sheet stretching board 48, suitable for provisionally supporting a stack and stretching said or each wing, with a portion of wing of sheet exceeding said sheet stretching board (FIG. 10; C10/I65-67). Schmidt, V et al. teaches the combination of air with a sheet stretching board to provide the flexibility to stretch a wing at any stack height to accommodate varying system speeds and product thicknesses. C11/L10. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Hauschild et al. to include moving a sheet stretching board and stretching said or each wing, as per the teachings of Schmidt, V et al., to accommodate different speeds and thicknesses.

Response to Arguments

Applicant's arguments filed April 11, 2007 have been fully considered but they are not persuasive. New claim 12 has been addressed on the merits above.

With respect to claim 1, Applicant argues that Schmidt does not disclose separation of the stack. Initially it is noted that claims 1 (& 12) merely require stack separation by insertion of separators from opposite sides of a stack being formed which leaves one wing hanging free. Schmidt's FIGS. 3 (non-separating position) and FIG. 5 (separating position) clearly show both separators 46, 50 inserted from opposite sides and a wing 70 hanging free such that a forming stack 58 is separate from a completed stack 30. Finally, Schmidt's fingers are certainly capable of supporting a stack, separator 46 from above and separator 50 from below. Whether Schmidt's fingers 38 & 40 separate is irrelevant because as is shown fingers 46 & 50 perform a separating step.

With respect to claim 1, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., supporting the stack with a stretching board) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is noted that, Applicant does not claim a method step, e.g. –supporting a stack with a sheet stretching board–, merely that it is suitable for supporting a stack. Schmidt's stretching board 48 is certainly suitable for supporting a stack insomuch FIG. 1 discloses support fingers 48 moving into a stacking chamber underneath a forming stack 58 and has supports 48 which one could certainly place a stack on. Whether Schmidt discloses the step of supporting a stack is not at issue because claims 1 & 12 do not recite this structure.

With respect to new claim 12, Applicant argues that one would not combine Hauschild with Schmidt because it would be duplicitous to add Schmidt's separating board with Hauschild's air blower. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, Schmidt acknowledges that air and separating boards are properly combined to provide the flexibility of stretching a wing at any stack height to accommodate varying system

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speeds and product thicknesses. C11/L10. Thus, the combination is proper and made final.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory W. Adams whose telephone number is (571) 272-8101. The examiner can normally be reached on M-Th, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene O. Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GWA


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SUPERVISORY PATENT EXAMINER